

This Opinion is not a
Precedent of the TTAB

Mailed: August 3, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Simply Southern Holdings, LLC
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Serial No. 90728560
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David W. Sar of Brooks, Pierce, McLendon, Humphrey & Leonard, LLP,
for Simply Southern Holdings, LLC.

April Roach, Trademark Examining Attorney, Law Office 115,
Daniel Brody, Managing Attorney.

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Before Shaw, Coggins and Lebow,
Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:

Simply Southern Holdings, LLC dba Simply Southern (“Applicant”) seeks registration on the Principal Register of the standard character mark S!MPLY for “Footwear, primarily made of ethylene-vinyl acetate; Slip-on shoes, primarily made of ethylene-vinyl acetate,” in International Class 25.¹

¹ Application Serial No. 90728560 was filed May 22, 2021, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging a date of first use anywhere and in commerce of December 31, 2020. Ethylene-vinyl acetate (“EVA”) is a rubber-like foam. June 3, 2022 Office Action, TSDR p. 7.

Citations to the prosecution file refer to the .pdf version of the USPTO’s Trademark Status & Document Retrieval (“TSDR”) system and identify documents by title and date. References

The Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, as used in connection with the above goods, so resembles the mark SIMPLY, also in standard characters, for "Dresses; Jumpsuits; Rompers," in International Class 25,² as to be likely to cause confusion, to cause mistake, or to deceive.

When the refusal was made final, Applicant appealed and requested reconsideration. Upon denial of the request for reconsideration, the appeal resumed. The case is fully briefed. We affirm the refusal to register the mark.

Our determination under Section 2(d) of the Trademark Act is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*DuPont*") cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015); see also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We must consider each *DuPont* factor for which there is evidence and argument. See, e.g., *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. See *In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc.*

to the briefs and other materials in the appeal record refer to the Board's TTABVUE online docketing system.

² Registration No. 5997750 issued February 25, 2020.

v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”); *see also In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus . . . on dispositive factors, such as similarity of the marks and relatedness of the goods.’”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

A. The similarity or dissimilarity of the marks in their entireties in terms of appearance, sound, connotation and commercial impression.

We begin with the *DuPont* factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567. “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. 2019). The emphasis of our analysis must be on the recollection of the average purchaser of footwear and clothing who normally retains a general, rather than specific, impression of trademarks. *In re Assoc. of the U.S. Army*, 85 USPQ2d 1264, 1268 (TTAB 2007); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Applicant’s mark is S!MPLY and Registrant’s mark is SIMPLY, both in standard characters. The only difference between the marks is that Applicant has substituted an exclamation point for the letter “I” in its mark.

Citing *In re Viterra, Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012) for the authority that there is no correct pronunciation of a mark, the Examining Attorney argues that “the compared marks could clearly be pronounced the same.”³ Therefore, according to the Examining Attorney, “the marks are phonetic equivalents and thus sound similar.”⁴

Applicant disagrees that the marks are similar in pronunciation:

With respect to the pronunciation of the marks, said aloud, the S!MPLY Mark is literally: “s, exclamation point, m, ply (or p-l-y).” It is not self-evident that consumers would understand the exclamation point to mean an “I” as opposed to most anything else – vowel, consonant, number or anything except an exclamation point. But, even if a consumer believed the exclamation point to stand in place of the letter “I,” the marks are still not phonetically equivalent because, in such a hypothetical situation, the S!MPLY Mark would be referred to as “simply, the one with the exclamation point[.]”⁵

Applicant’s argument that its mark “said aloud . . . is literally: ‘s, exclamation point, m, ply (or p-l-y)”⁶ strains credulity. Rather, we find it likely that consumers would pronounce Applicant’s mark as “simply,” the same as Registrant’s mark. This finding is supported by Applicant’s own specimen which includes the S!MPLY mark and a tag line stating: “be you and live simply.” The fact that an exclamation point is similar to an inverted lowercase letter “i” further supports this finding.

³ Examining Attorney’s Br., p. 4, 8 TTABVUE 4.

⁴ *Id.* at 5, 8 TTABVUE 5.

⁵ Applicant’s Br., p. 4, 6 TTABVUE 8.

⁶ *Id.*

Applicant also argues that its mark is distinguishable from Registrant's mark because other pairs of marks comprising different terms with similar typographical substitutions, have been registered by unrelated third parties for various articles of clothing. For support, Applicant points to marks such as P*NK! and PINK, ENDUR3 and ENDURE, and \$0L!D!/SOLID and two SOLID and design marks.⁷

This argument is unpersuasive. The fact that other marks with different terms and different special characters may coexist for clothing does not compel a finding that Applicant's and Registrant's marks are distinguishable merely because Applicant's mark includes an exclamation point. We have no information about the circumstances during the time the third-party marks coexisted; whether the marks may have been used under license; or whether there may have been third-party uses that resulted in marks that were not as strong as Registrant's mark herein. Rather, we must assess the issue of likelihood of confusion based on the record adduced in this proceeding.

Regarding connotation and commercial impression, Applicant argues that "[w]hen the S!MPLY Mark is viewed as a whole, it creates a different commercial impression from the Registered Mark. The S!MPLY Mark is more memorable and intentionally has a different appearance than the word 'SIMPLY' alone."⁸ We disagree with this contention as well. The substitution of an exclamation point for the letter "I" does little to change the commercial impression of Applicant's mark so as to distinguish it

⁷ *Id.* at 5, 6 TTABVUE 9; November 16, 2022 Request for Reconsideration, TSDR pp. 15-40, 78-96.

⁸ Applicant's Br., p. 4, 6 TTABVUE 8.

from the registered mark. Slight differences in pronunciation, connotation and commercial impression normally do not create legally dissimilar marks. *See, e.g., Viterra*, 101 USPQ2d at 1912 (XCEED and X-Seed and design similar); *In re Great Lakes Canning, Inc.*, 227 USPQ 483, 485 (TTAB 1985) (CAYNA similar to CANA); *In re Bear Brand Hosiery Co.*, 194 USPQ 444, 445-46 (TTAB 1977) (KIKS similar to KIKI).

We also note that since both Applicant's mark and the cited mark are in standard characters, they may be presented in any style, regardless of font, size, or color. *See Viterra*, 101 USPQ2d at 1909. Thus, Applicant's mark could be displayed in lettering the same as or significantly resembling that of the cited mark.

For the foregoing reasons, we find that the marks are similar in sound, connotation and commercial impression. The first *DuPont* factor favors a finding of likelihood of confusion.

B. The nature and similarity or dissimilarity of the goods, the established, likely-to-continue trade channels, and the classes of purchasers.

We next consider the second and third *DuPont* factors which address the relatedness of the goods, the trade channels in which they travel, and the classes of consumers of such goods. The goods need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000). When considering the goods and services, trade channels, classes of consumers and conditions of sale, we must make our determinations based on the goods as they are identified in the application and cited

registration. *See In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997); *Stone Lion Cap. Partners, L.P. v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014).

Applicant's goods are footwear and slip-on shoes, primarily made of ethylene-vinyl acetate. Registrant's goods are dresses, jumpsuits, and rompers. In support of the refusal to register, the Examining Attorney submitted internet webpage excerpts showing that footwear and dresses, jumpsuits, and rompers are commonly made and sold under a single mark. For example, retail webpages from Kate Spade, Boden, Roxy, Olukai, Ugg, Fila, Hoka, Merrell, and Puma all show use of a single mark for footwear as well as a variety of clothing, including dresses, jumpsuits, or rompers.⁹ Notably, the footwear on these websites are made from a variety of materials, including, leather, fabric, rubber, and EVA foam.

Based on the record before us, we find Applicant's and Registrant's goods are related. *See In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991) (ESSENTIALS in stylized form for women's shoes against ESSENTIALS for women's clothing, namely, pants, blouses, shorts, and jackets); *In re Apparel Ventures, Inc.*, 229 USPQ 225 (TTAB 1986) (SPARKS BY SASSAFRAS in stylized form for women's separates, namely blouses, skirts and sweaters against SPARKS in stylized form for shoes, boots and slippers); *In re Pix of Am., Inc.*, 225 USPQ 691 (TTAB 1985) (NEWPORTS for women's shoes against NEWPORT for outer shirts); *In re Alfred Dunhill Ltd.*, 224

⁹ Office Action of November 30, 2021, TSDR pp. 7-40; Final Office Action of June 3, 2022, TSDR pp. 7-82; December 20, 2022 Denial of Request for Reconsideration, TSDR pp. 8-32.

USPQ 501 (TTAB 1984) (DUNHILL in stylized lettering for various items of men's clothing including belts against DUNHILL for shoes); and *In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984) (BOOMERANG for athletic shoes against BOOMERANG and design for men's shirts).

Applicant nevertheless argues that the third-party evidence is insufficient because "there is no evidence that dresses, jumpsuits, or rompers are themselves made with ethylene-vinyl acetate. Thus, the scope of the Registered Mark's registration does not encompass those covered by the S!MPLY Mark and undermines the assertion of relatedness of the goods covered by both marks." Applicant is incorrect. It is not necessary that Applicant's goods be encompassed by Registrant's goods or made from the same material. The goods need only be "related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [they] emanate from the same source." *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)).

Regarding channels of trade and classes of consumers, we find the Examining Attorney's evidence also establishes that the respective goods are sold through the same types of online retail stores to some of the same consumers.

We find that the *DuPont* factors regarding the similarity of goods, channels of trade, and classes of purchasers favor a finding of likelihood of confusion as to Applicant's goods in class 25.

C. Conclusion

The similarity of the respective marks for related articles of clothing, which move in the same channels of trade to the same classes of customers, renders confusion likely.

Decision: The Section 2(d) refusal to register Applicant's mark is affirmed.